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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,573	11/24/2003	Kiyoshi Yuri	03696/LH	9922
1933 7590 08/12/2009 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER CZEKAJ, DAVID J				
ART UNIT 2621		PAPER NUMBER		
MAIL DATE 08/12/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/723,573

**Applicant(s)**

YURI, KIYOSHI

**Examiner**

DAVID CZEKAJ

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

On pages 4-7, applicant argues that Douglass fails to disclose setting a plurality of positions in an XY direction over a sample image area, acquiring a height coordinate in these positions, and setting a position on a grid point by dividing the sample image area at predetermined intervals in grid form. While the applicant's points are understood, the examiner respectfully disagrees. See for example Douglass column 11, lines 24-30 and 42-47. There Douglass discloses dividing the sample image area into a 3x3 grid of points centered on the scan area. Douglass further discloses in column 11, lines 54-57, that this processing provides the Z, or height coordinate, position information for the image area. Therefore the rejection has been maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglass et al. (6215892), (hereinafter referred to as "Douglass") in view of Gagnon et al. (7027628), (hereinafter referred to as "Gagnon").

Regarding claim 1, as shown in Figure 2, Douglass teaches a system for a microscopic image capture apparatus. The apparatus includes a low magnification optical system and a high magnification optical system (44 and

44a, Fig. 4). Note, the turret (44) changes the magnification. The system further includes the hardware to provide an automated scanning for candidate cells at a low magnification, refocusing at a higher magnification and performing further analysis to confirm the cell candidate (Col 5 Line 55-Col 6 Line 10). The system is run by a system processor (23) and microscope controller (31) (Col 5 Lines 20-34).

The system performs the operation of capturing an image of a wide-angle view of an entire observing slide by a low magnification optical system and extracting a sample image area including a sample image from the captured image of wide-angle view (Col 10 Lines 12-21).

Douglass further teaches one method of performing auto focus at a high magnification is to automatically set a plurality of horizontal positions in which a height coordinate Z is acquired from the extracted sample image area and reading a height coordinate which is a focal point position of the high magnification optical system in each of the set horizontal positions (Col 11 Lines 9-12, Col 11 Lines 24-40, Col 12 Lines 20-26). Once the focus positions are obtained for the set horizontal positions, adjusted position of a focal point in an arbitrary position in the sample image area using the set horizontal positions and height coordinate data is computed (Col 11 Lines 57-65). The height value is used to adjust the microscope in order to capture an image (Col 11 Lines 61-62) and setting a position of a grid point including the sample image in grid points by dividing the image at predetermined intervals in grid form (Douglass: column 11,

lines 24-60). However, Douglass fails to disclose the Z coordinate calculation as claimed. Gagnon teaches that prior art processing systems tend to have slides that deteriorate over time and are unavailable (Gagnon: column 1, lines 59-67). To help alleviate this need, Gagnon teaches automatically setting a plurality of positions over the sample in each of which a height coordinate Z is acquired (Gagnon: column 6, lines 35-67; column 7, lines 1-32. By applying correction data to the Z position, the current Z position must be known in order to apply the proper amount of correction data). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Douglass and add the Z processing taught by Gagnon in order to help increase the life of the slides and the available of the samples.

Regarding claim 2, Douglass further teaches the apparatus uses a grid of points centered on the scan area and obtains focus positions using the auto-focusing method of Figure 13a (Col 11 Lines 41-56, Figs 14 and 15). As shown in Figure 15, the grid points are at predetermined intervals.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID CZEKAJ whose telephone number is (571)272-7327. The examiner can normally be reached on Mon-Thurs and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dave Czekaj/

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Primary Examiner, Art Unit 2621